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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,794	09/11/2003	Dario Sansone	08350.1767-00000	4545

22852 7590 11/15/2005

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EXAMINER

HURLEY, KEVIN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Election/Restrictions

1. **37 CFR 1.176 Examination of reissue.**

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-61, and 71-86 drawn to a steerable machine, classified in class 180, subclass 9.46.
- II. Claims 62-70, drawn to a method of operating a machine, classified in class 180, subclass 411.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product since it does not require the particulars of either claims 1 or 9. Therefore, for example, a machine without a driver's cab or actuators could be used.

4. As set for the in MPEP 1450, where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected and the added claims to be constructively non-elected and withdrawn from consideration.

Newly submitted claims 62-70 are withdrawn from consideration.

If the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.

Reissue Applications

5. Claims 12-47 rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The "patent claims," in the context of recapture case law, are claims which issued in the

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original patent for which reissue is now being sought. Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

In parent application 09/531,565 the amendment filed 15 May 2001, it was argued on pages 8-10 the following:

“Claims 1-10 are rejected under 35 U.S. C. § 102(b) as being clearly anticipated by the Files reference.

The Files reference does not show or disclose the elements of the second actuator having a second rod end fixed to the plate as claimed in the present invention. In the Files reference, the hydraulic cylinder 32 is in communication with the piston rod 34 that is connected to cross-pin 25, not a plate, as claimed.

The Files patent also lacks the element of the first articulation means being for moving the chassis with respect to a fixed point on the frame in order to move the rear support inward of the frame, as claimed in the present invention. In Files, the articulation 49 does not allow for the chassis to move *inward of the frame*, as presently claimed. As shown in Fig. 2, the cylinder 51 would prevent such movement inward of the frame. Actually, the chassis 45 would have a very limited range of motion, most likely less than 180 degrees, which would ultimately not allow the chassis to move inward of the frame, only toward it.

The Files device also fails to show or disclose the element of the first actuator having a first hydraulic jack with a first rod end fixed to the yoke, as presently claimed. The Files device shows a cylinder 51 that is connected to control arm 57. The control arm 57 is connected to collar 42 which in turn is connected to

bearing rings 44. (File, Fig. 5). Thus the rod 54 of cylinder 51 is not connected to the yoke 23.

Since the Files reference fails to show or disclose all the elements of the claimed invention, it fails to anticipate the claimed invention.”

“New claims 12-14 are patentable over the cited prior art of record because the prior art lacks a steerable machine having a pair of rollable front supports that are rotatable about a front vertical axis and are controlled by power steering. The prior art also lacks a pair of rollable rear supports that are pivotable about a rear vertical axis and are controlled by a steering hydraulic cylinder.

Since the Files reference fails to show or disclose all of the elements of the claimed invention, it fails to anticipate the claimed invention.”

Since claims 12-37 omit the limitations argued for the patentability of claims 1-10, as well as claims 12-14, claims 12- are barred by the recapture rule.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 23, 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23 line 2 it is unclear if “a first actuator” is the same one recited in claim 1 as “at least one first actuator”.

In claim 37 line 2 it is unclear if “a first actuator coupled to the first rear support” is the

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same one recited in claim 1 as "at least one steering hydraulic actuator configured to steer the first said rear support".

Allowable Subject Matter

8. Claims 1-11, 48-61, 71-86 are allowed.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Hurley whose telephone number is 571-272-6646. The examiner can normally be reached on Monday-Friday 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kevin Hurley
Primary Examiner
Art Unit 3611

November 10, 2005